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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/456,576      | 06/09/2003  | Lawrence G. Anderson | 03626.0019-01       | 9618             |

22852 7590 11/29/2004

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EXAMINER

LU, C CAIXIA

ART UNIT PAPER NUMBER

1713

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

DEC 01 2004

FINNEGAN, HENDERSON, FARABOW,  
GARRETT AND DUNNER, LLP

Docketed 12-01-04 Attorney TLI/MDS/CEH

Case 03626.0019-01

Due Date 02-29-05

Action Response due

By ms

**Office Action Summary**

Application No.

10/456,576

Applicant(s)

ANDERSON ET AL.

Examiner

Caixia Lu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 150 and 190-256 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 150 and 190-256 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/09/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 150 and 190-256 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 150, line 13, the use of the term "one material" is indefinite since it not clear whether "one material" refers to component (a) or (a) of the instant claim.

OK

Claim 191 is not further limiting and, thus, should be canceled.

OK

In at least claims 190, 200, 207, 214, 219, 223, 224, the selective formats of various groups are improper in that it is not clear whether the individual members in the group are selected in alternatives only or in both alternatives and combinations. In general, when the members of in the group are individually chosen as alternatives, the format, "selected from A, B,..., or X" or "selected from the group consisting of A, B,..., and X", should be used; and when the members in the group are chosen both in alternatives and combinations, the format "selected from the group consisting of A, B,..., X, and mixtures thereof" should be used. See MPEP 2173.05 (h). Applicants are requested to amend the selective formats for all of the claims according to the above guidance.

argue

Claim 195, lines 14-16, symbols "Ra" and "R3" are ill formatted and proper corrections are requested.

OK

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***Allowable Subject Matter***

3. All of the pending claims would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The instant application is a divisional application of application SN 09/629,420. Since the instant claims share the same scope of novelty as the claims of the parent application, thus, for the same reason as stated in the parent application which is repeated as the following, the instant claims are deemed to be novel.

"The working Examples 1-9, and 11 of Ohsugi et al. (US 5,066,720) teaches a curable coating composition comprising a hydroxyl functional group containing siloxane, an aminoplast curing agent such as melamine-formaldehyde resin, a titanium dioxide filler, and hydroxyl containing acrylic resin. While the cited prior art seems to generally to have similar components of the siloxane composition as that of the instant claims, the structures of those components are not identical to those of the working examples of the instant applications. Thus, one would not have expected that the siloxane compositions of the cited prior art when cured have scratch resistance value such that after scratch testing greater than 40 % of the initial 20° gloss is retained as the siloxane composition of the instant claims. Therefore, the instant claims are deemed to be novel."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caixia Lu whose telephone number is (571) 272-1106. The examiner can normally be reached from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful and the matter is urgent, the examiner's supervisor, David Wu, can be reached at (571) 272-1114. The

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fax numbers for the organization where this application or proceeding is assigned is  
(703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1700.

A handwritten signature in black ink, appearing to read 'Caixia Lu'.

Caixia Lu, Ph. D.  
Primary Examiner  
November 24, 2004